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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,002	11/09/2000	Minegishi Yukio	09564/002001	5998

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EXAMINER	
FERNSTROM, KURT	

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 11/03/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/711,002	Applicant(s) YUKIO ET AL.	
	Examiner Kurt Fernstrom	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2003 and 12 August 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a medium upon which is provided a plurality of "thought units," each of which displays a plurality of "thought results." The "thought results" appear to be the thoughts of various participants of a meeting, which are not patentable subject matter.

The Federal Circuit has applied the practical application test to determine whether claimed subject matter is patentable under 35 USC 101. *ATT Corp. V. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. V. Signature Financial Group Inc.,* 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998). The test for practical application requires that a "useful, concrete and tangible result" be accomplished. The present invention does not meet the last two requirements of the test, that is; it does not produce a result which is concrete or tangible. The thoughts of a person are subjective and indefinite, and not tangible or concrete. Also, the invention is not within the technological arts, as no technology is being employed as part of the claimed invention.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 8-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Because the invention does not produce a concrete or tangible result, the invention cannot operate as intended without undue experimentation.

Response to Arguments

5. Applicant's arguments filed on July 15, 2003 have been fully considered but they are not persuasive.

The apparatus which displays the thought results of the invention is not sufficient to provide a "practical application" to the invention. The claims remain rejected under 35 USC 101 under the rationale of In re Abele, 684 F.2d 902, 214 USPQ2d 682 (1982), which held that the step of displaying a calculation was not sufficient to overcome the rejections made under 35 USC 101. It should also be noted that Abele did not draw a distinction between the apparatus claim 7 reciting a display, and the method claim 5 which recited a method of displaying the data. Here, the claimed invention is not considered to be a product arrived at by grouping of thought results,

but merely a display of the thought results themselves. The thought results are not incidental to the invention, but rather they essentially comprise the invention. The device itself has no utility apart from displaying the thought results of the invention. To the extent that the display is helpful in arriving at a solution to the problem, such a solution, like the thought results themselves, are the result of the subjective determination of the users of the device. The amendment fails to overcome the rejections because while the thought results have been limited to certain categories, these categories remain subjective, and the result of creative thought processes of the users. Also, while it is appreciated that the invention comprises the sorting and placement of the thought results in specific areas, this feature amounts to the manipulation of the abstract ideas formed by the thought results. An invention which consists of nothing more than the manipulation of abstract does not meet the requirements of 35 USC 101. See *In re Warmerdam*, 31 USPQ2d 1754 (1994).

Also, the claimed invention is not considered to be within the technological arts, particularly with respect to claims 8-11 and 13-16. The apparatus consists essentially of thought results being displayed on a medium. The provision of the medium itself, in these claims a piece of paper, is not sufficient to bring the invention within the scope of that which advances the technological arts, and thus would be patentable subject matter. See (Unpublished) Ex Parte Bowman , 61 USPQ2d 1669 (BdPatApp&Int 2001), which held that an abstract idea is not transformed into patentable technological art by recited steps of "transforming physical media into a chart" and "physically plotting a point on said chart." Although Bowman does not directly

address the issue of displaying the results on a computer, as in claims 12 and 17 of the present invention, the inclusion of a computer is not considered to bring the subject matter into that what advances the technological arts. Although computer devices are generally considered to be within the technological arts, here the computer acts merely as a display medium for displaying thought results. The technology of the computer itself is not being used in a way that would provide any particular advantages over the display on a sheet of paper. Also, Applicant's characterization of claims 8 and 14 on page 8 of the remarks is contested. The claims do not recite storage or retrieval of data. The claims only recite that the thought results are displayed on a medium, and that the medium is a computer display. With respect to the two prong test of MPEP 2106 cited by applicant, here there is no physical transformation outside the computer, nor is there a practical application within the technological arts, for the reasons set forth above.

The arguments presented concerning Alappat and Diehr are not persuasive because those holdings concerned inventions which were machines and machine processes. Alappat was directed to a means for creating a smooth waveform display in a digital oscilloscope. Diehr was directed to a process for molding raw, uncured synthetic rubber into cured precision products. In particular, Diehr based its holding in large part on the transformation of physical matter into a different state. The present invention is considered to be much more analogous to those of Abele and Bowman.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

November 1, 2003

Kurt Fernstrom